

Remarks

Claims 1-22 were pending in the subject application. By this Amendment, the applicants have amended claims 1, 4, 15 and 28 and cancelled claim 22. No new matter has been added by these amendments. Support for these amendments can be found at, for example, page 5, line 19 of the specification. Accordingly, claims 1-21 are now before the Examiner for consideration.

The amendments to the claims have been made in an effort to lend greater clarity to the claimed subject matter and to expedite prosecution. The amendments should not be taken to indicate the applicants' agreement with, or acquiescence to, the rejection of record. Favorable consideration of the claims now presented, in view of the remarks and amendments set forth herein, is earnestly solicited.

Claims 1-5, 7-11, 13-16 and 19-22 have been rejected under 35 U.S.C. §102(e) as being anticipated by Jensen *et al.* (U.S. Patent Application No. 2004/0077075). The applicants respectfully traverse this rejection because the cited reference is not available as prior art and because, even if this reference were available as prior art, it does not disclose or suggest the applicants' method as now claimed.

It is a basic premise of patent law that, in order to anticipate, a single prior art reference must disclose within its four corners, each and every element of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears Roebuck and Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. USITC*, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSIH, supra*; *Kalman [v. Kimberly-Clarke]*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)] (emphasis added). 221 USPQ at 485.

The Jensen *et al.* reference does not disclose each and every element of the method as claimed by the current applicants. For example, Jensen *et al.* do not disclose a method that utilizes a device with a maximum chamber volume of only 1  $\mu$ L. Accordingly, the applicants respectfully submit that their claims, as currently amended, are not anticipated by the disclosure of Jensen *et al.*

Furthermore, the applicants respectfully submit that the Jensen *et al.* reference is not available as prior art against the current application. With their previous Responses (dated July 17, 2008 and August 26, 2008) the applicants submitted a Declaration under 37 CFR §1.131 showing that the co-inventors of the present application conceived of the subject matter of the invention prior to May 1, 2002, and further stating that the applicants diligently worked on the invention at least until the filing date of the United Kingdom application from which the subject application claims priority. Thus, because the filing date of the earliest application from which Jensen *et al.* claims priority is May 1, 2002, the Jensen reference is not prior art.

The outstanding Office Action states that the previously-submitted Declaration contains insufficient information to establish the required diligence from a time just before the effective date of the Jensen *et al.* reference (May 1, 2002) until the filing date of the applicants' UK application (July 9, 2002).

Attached herewith is a further Declaration, with accompanying Exhibits, executed by Mr. Robert Perry, the European Patent attorney who met with the inventors and drafted and filed the UK patent application. Mr. Perry's Declaration (and accompanying Exhibits) establish that the applicants diligently worked on this invention from prior to May 1, 2002 until at least July 9, 2002. Specifically, as evidenced by their monthly technical reports, substantial technical activity took place during April, May, June, and July of 2002. Furthermore, as attested to by Mr. Perry, he met with the inventors on May 20, 2002 and proceeded to diligently draft a patent application, and have that application reviewed, revised and filed by July 9, 2002.

With regard to the nature of evidence to be submitted during prosecution to establish conception and diligence, 37 CFR §1.131(b) states as follows:

b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

In the current case, the Declarations and Exhibits provided by the applicants clearly establish that the time from May 1, 2002 to July 9, 2002 were filled with activity on this project including technical advances as well as the drafting, review, and filing of a patent application.

Thus, while the applicants do not agree that Jensen *et al.* disclose each and every aspect of the claimed invention, because the Jensen *et al.* reference is not available as prior art, the rejection under 35 U.S.C. §102(e) is moot. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §102 based on Jensen *et al.*

Claim 6 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Jensen *et al.* as applied to claims 1-5, 7-11, 13-16, and 19-22 above, and further in view of Wada *et al.* (WO 99/67639). Also, claims 12 and 22 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Jensen *et al.* as applied to claims 1-5, 7-11, 13-16, and 19-22 above, and further in view of Lowe *et al.* (U.S. Patent No. 5,989,923). Finally, claims 17 and 18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Jensen *et al.* as applied to claims 1-5, 7-11, 13-16, and 19-22 above, and further in view of Walker *et al.* (U.S. Patent No. 5,474,774) and Qian *et al.* (Analytical Chemistry, 2002). The applicants traverse each of these grounds for rejection because the cited references, either taken alone or in combination, do not disclose or suggest the claimed invention.

The shortcomings of the primary Jensen *et al.* reference, as that reference relates to the current invention, have been discussed above. The secondary references cited in the various obviousness rejections do not cure or even address these shortcomings. For example, none of these references provides any teaching that would lead one skilled in the art to the current applicants' method in which a device is used that has a maximum chamber volume of 1  $\mu$ L.

While the applicants do not agree that the claimed invention is rendered obvious by any of the combinations of references cited under 35 U.S.C. §103, the applicants respectfully point out that each of these rejections is based on Jensen *et al.* as the primary reference. As noted above with respect to the rejection under 35 U.S.C. §102(e), the Jensen reference is not prior art. None of the secondary references (Wada *et al.*, Lowe *et al.*, Walker *et al.*, or Qian *et al.*) disclose or even suggest the novel and advantageous methods of the claimed invention and, thus, cannot stand on their own. Accordingly, the applicants respectfully request reconsideration and withdrawal of each of the rejections under 35 U.S.C. §103.

Claims 1, 3, 9-12, 14, 16, 19, and 20 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 8, and 14 of copending Application No. 10/520,331. Upon indication of allowance of the copending '331 application, the applicants will file a Terminal Disclaimer at that time if it is necessary.

In view of the foregoing remarks and the amendments above, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicants also invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



David R. Saliwanchik  
Patent Attorney  
Registration No. 31,794  
Phone: 352-375-8100  
Fax No.: 352-372-5800  
Address: P.O. Box 142950  
Gainesville, FL 32614-2950

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Attachments: Declaration of Robert Edward Perry  
Exhibit A  
Exhibit B  
Exhibit C  
Exhibit D